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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/725,717 | 11/30/2000 | Dale W. Malik | BS00-168 | 1249 |

28970 7590 03/03/2004

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EXAMINER

VU, THONG H

| ART UNIT | PAPER NUMBER |
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2142

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,717

Applicant(s)

MALIK, DALE W.

Examiner

Thong H Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-28 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7;21-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Zoken [5,944,787] in view of Donaldson [6,321,267 B1].

3. As per claim 1, Zoken discloses a method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising the steps of:

(a) storing a list of domain names in a memory [Zoken, database, col 3 lines 16-67; col 4 lines 8-26];

(b) checking if a domain name of the e-mail address provided in the e-mail communication is included in the list of domain names in the memory [Zoken, email mapper detects the first, second and third Domain name of email address, col 54 line 28-col 5 line 12]; and

However Zoken does not detail (c) generating a prompt for a user to confirm an e-mail address if the domain name is not included in the list of domain names.

A skilled artisan would have motivation to implement the filtering process and found Donaldson teaching. Donaldson discloses a method and system for filtering junk email wherein the active filter has not found the domain address and it writes (i.e.:

Art Unit: 2142

prompt) an error message, request a confirm by the database, or notify to user

[Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

An Official Notice is taken that the email filters which detects the spam, virus or misspell or spell check were well-known in the art [see Rollins, Aronson, Nielsen references]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the filter agent generating a confirm message or error message as taught by Donaldson into Zoken's apparatus in order to utilize the filter process. Doing so would provide a dynamic and simple process to verify the resources on Internet.

4. Claims 21,26 contain the similar limitations set forth of apparatus claim 1.

Therefore, claims 21,26 are rejected for the similar rationale set forth in claim 1.

5. As per claim 2, Zoken-Donaldson disclose extracting a domain name from each e-mail address provided in the outgoing e-mail communication, wherein the e-mail communication is transmitted after checking each extracted domain name in the list of domain names, and confirming each e-mail address for which the extracted domain name is not included in the list of domain names [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

6. As per claim 3, Zoken-Donaldson disclose the domain names, in the list of domain names stored in the memory are extracted from senders' e-mail addresses from incoming e-mail communications [Zoken, email mapper detects the first, second and third Domain name of email address, col 54 line 28-col 5 line 12].

7. As per claim 4, Zoken-Donaldson disclose receiving a corrected e-mail address from the user in response to the prompt; and repeating the steps of checking a corrected domain name and generating a prompt if the corrected domain name is not included in the list of domain names, until the user either confirms that the domain name provided in the e-mail address is correct or provides a domain name that is in the list of domain names [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

8. As per claim 5, Zoken-Donaldson disclose the outgoing e-mail communication is intercepted in an e-mail server to check the domain name in the e-mail address prior to transmission [Zoken, email mapper, col 54 line 28-col 5 line 12].

9. As per claim 6, Zoken-Donaldson disclose the prompt is an e-mail message from the e-mail server to the user [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

10. As per claim 7, Zoken-Donaldson disclose the prompt is a network message to the user [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

11. As per claim 22, Zoken-Donaldson disclose the e-mail addresses in the list of e-mail addresses stored in the memory are senders' e-mail addresses extracted from incoming e-mail communications [Donaldson col 2 lines 48-62].

12. As per claim 23, Zoken-Donaldson disclose storing tally information (i.e.: frequency tally tracks how often a user received email from a certain address) in the memory to tally the frequency by which the e-mail addresses are extracted from incoming e-mail communications [Zoken, tracking how often one message sent from a company to a particular division, col 6 lines 26-45].

13. As per claim 24, Zoken-Donaldson disclose deleting e-mail addresses from the memory that are not frequently extracted from incoming e-mail communications according to respective tally information [Donaldson, edit or delete, col 18 lines 24-32; col24 lines 47-64;col 25 lines 1-24].

14. As per claim 25, Zoken-Donaldson disclose the memory is in an e-mail address directory in a client computer system [Zoken, whitepage database, abstract].

15. As per claim 27, Zoken-Donaldson disclose the memory is included in an e-mail address directory [Zoken, domain naming hierarchy, col 5 lines 4-12].

16. As per claim 28, Zoken-Donaldson disclose the e-mail address directory additionally stores user-specified e-mail addresses [Zoken, a list of address 15, Fig 1, col 3 lines 15-40].

17. Claims 8-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Zoken [5,944,787] in view of Donaldson [6,321,267 B1] and further in view of Rollins [6,434,601 B1]

18. As per claim 8, Zoken discloses a method of automatically checking for (misspelled) e-mail addresses in out going e-mail communications prior to transmission by an e-mail communications server [see claim 1 rejection]

However Zoken-Donaldson did not detail the misspelled email address or domain name. A skilled artisan would have motivation to implement the email software and found Rollins teaching. Rollins discloses a pre-test email process wherein the email software program verifies a misspelling in the email address, server name (i.e.: domain name) [Rollins abstract](see Nielsen reference as an alternative).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the testing to verify the misspelling server name, email address as taught by Rollins into the Zoken-Donaldson apparatus in order to utilize the filtering process. Doing so would provide a quick, simple and effective to send and receive Email over Internet.

19. Claim 18 contains the similar limitations set forth of apparatus claim 8. Therefore, claims 18 is rejected for the similar rationale set forth in claim 8.

20. As per claim 9, Zoken-Doanldson-Rollins disclose searching for similarly spelled domain names is performed by checking each alpha numeric character comprised in the extracted domain name with the alpha-numeric characters comprised in the domain names in the database, and detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name [Zoken, search database, col 6 lines 46-67].

21. As per claim 10, Zoken-Doanldson-Rollins disclose searching for similarly spelled domain names is performed by removing an alpha numeric character from the extracted domain name and searching the domain name database for a domain name consisting of at, least each of the remaining alpha numeric characters in the extracted domain name [Zoken, search database, col 6 lines 46-67].

22. As per claim 11, Zoken-Doanldson-Rollins disclose searching for similarly spelled domain names is performed by comparing the extracted domain name with reference domain names stored in the domain name database according to predetermined spelling grammar algorithms [Zoken, search database, col 6 lines 46-67].

Art Unit: 2142

23. As per claim 12, Zoken-Doanldson-Rollins disclose the error prompt is an e-mail message from the e-mail server to the client computer transmitting the e-mail communication [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

24. As per claim 13, Zoken-Doanldson-Rollins disclose the error prompt is a network message from the e-mail server to the client computer transmitting the e-mail communication [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

25. As per claim 14, Zoken-Doanldson-Rollins disclose determining whether extracted domain names are already stored in the domain name database, whereby only a single copy of an extracted domain name is stored in the domain name database.

26. As per claim 15, Zoken-Doanldson-Rollins disclose storing tally information in the domain name database to tally the frequency in which domain names in the domain name database are extracted from incoming e-mail communications [Zoken, tracking how often one message sent from a company to a particular division, col 6 lines 26-45].

27. As per claim 16, Zoken-Doanldson-Rollins disclose deleting domain names from the domain name database that are not frequently extracted from incoming e-mail communications according to respective tally information [Donaldson, edit or delete, col 18 lines 24-32; col24 lines 47-64;col 25 lines 1-24].

Art Unit: 2142

28. As per claim 17, Zoken-Doanldson-Rollins disclose the tally information for each domain name in the domain name database includes the calendar date in which the domain name was most recently extracted [Donaldson col 3 lines 15-23, col 17 lines 49-64].

29. As per claim 19, Zoken-Doanldson-Rollins disclose (d) an internal network communications interface for receiving outgoing e mail communications to be transmitted from client computers and sending incoming e-mail communications to client computers, wherein the e-mail checker generates an error prompt when detecting a misspelled domain name, which is transmitted from the internal network (i.e.:LAN) communications interface to the client computer requesting transmission of the corresponding outgoing e-mail communication [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

30. As per claim 20, Zoken-Doanldson-Rollins disclose (e) an external network communications interface for receiving incoming e-mail communications from an external network and sending outgoing e-mail communications transmitted from client computer connected to the internal network, wherein outgoing e-mail communications are transmitted from the external network communications interface to the external network (i.e.: Internet) after the checker confirms e-mail address spelling in the outgoing e-mail communications [Donaldson, col 33 lines 13-23; col 6 lines 25-53; col 27 lines 4-11].

Art Unit: 2142

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
Art Unit 2142

